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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,831	02/12/2004	Trent D. Galloway	MB6245.001	5694
23875	7590	09/22/2004		EXAMINER
MOLLY D MCKAY, PC 3207 E 22ND STREET TULSA, OK 74114-1823				LEGESSE, NINI F
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/777,831	GALLOWAY, TRENT D. <i>DK</i>
	Examiner Nini F. Legesse	Art Unit 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 12 February 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-9 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received

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**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/12/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### *Specification*

On page 6, lines 4-5 the expression "the first plug 24 is provided at a grip end 28 of the first weight 14, and the second plug 26 is provided at an opposite head end 30 of the first weight" is not correct because referring to Figs. 1 and 2, first plug item 24 is shown at the head end of the first weight and second plug 26 is provided at the grip end of the first weight. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Laibangyang (US Patent No. 6,241,623).**

**With respect to claim 1, Laibangyang discloses:**

- A flexible hollow shaft (22 and column 5, lines 63-64);
- A first weight (28C) secured internally within the shaft between a head end of the shaft where the shaft attaches to a club head and a grip end of the shaft where a training club grip attaches to the shaft (see Fig 2);
- A second weight (28F) secured internally within the shaft at the head end of the shaft (see Fig. 2),

- A club head (24) attached to the head end of the shaft by a hosel provided on the club head (see Fig. 2),
- A training club grip (14 and 18) secured to an upper end of the shaft.

**With respect to claim 2,** Laibangyang discloses the first weight (28C) secured within the shaft (22) between a first lower plug (36) and a second upper plug (62).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1- 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannon et al. (US Patent No. 5,554,078) in view of Fisher (US Patent No. 6,287,215).**

**With respect to claim 1,** Hannon discloses a golf club comprising:

- A flexible hollow shaft (12, all golf club shafts are flexible to some degree);
- A first weight (32) secured internally within the shaft between a head end of the shaft where the shaft attaches to a club head and a grip end of the shaft where a training club grip attaches to the shaft (see Fig 2);
- A club head (22) attached to the head end of the shaft by a hosel (see Fig. 1);  
and
- A training club grip (20) secured to an upper end of the shaft.

Hannon discloses the invention as recited above but fails to include a second weight secured internally within the shaft at the head end of the shaft. Fisher teaches the use of a weight (slug 90) that is secured internally within the shaft at the head end of the shaft (Fig. 5B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a weight at the head end of the shaft in the Hannon's device as taught by Fisher in order to provide weight balance, vibration or damping characteristics to the golf club as stated in column 6, lines 56-57 of the Fisher reference.

**With respect to claim 2**, Hannon discloses the first weight (34) secured within the shaft (12) between a first lower plug (28) and a second upper plug (30).

**With respect to claim 3**, Hannon discloses that the plugs could be made of any low-density materials (see column 8, lines 11-13) but he does not explicitly state the use of an EPDM tapered plug for the lower plug and a silicon gel plug for the upper plug. At the time the invention was made, it would have been an obvious alternative material choice to a person of ordinary skill in the art to use plugs made of EPDM or silicon gel or, for that matter, any other material as plug material because Applicant has not disclosed that the use of these materials provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with cork or other low density materials as taught by Hannon because Hannon's or Applicant's plugs all perform the same function of positioning weight elements at a specific location inside a hollow golf shaft. Therefore it would have been an obvious alternative choice to modify Hannon to obtain the invention as specified in claim 3.

**With respect to claim 4,** Hannon discloses wherein the first weight extends from approximately 4 inches above the hosel to approximately 2 inches below a bottom of the training club grip. Column 4, lines 35-43 indicate that the location of the weight element in the invention is variable. Therefore Hannon's invention is capable of obtaining the specified location in this claim.

**With respect to claim 5,** Hannon discloses wherein the weight is approximately 6 ounces. For example in column 5, line 37 he indicates a weight means that is between 182-570 grams and 182 gram is approximately 6 ounce.

**With respect to claim 6,** Hannon does not explicitly state the use of #9 buckshot as a weight. At the time the invention was made, it would have been an obvious alternative material choice to a person of ordinary skill in the art to use #9 buckshot or, for that matter, any other weight material because Applicant has not disclosed that the use of this material provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with lead, copper, brass, zinc, steel, depleted uranium or other material of sufficient density as taught by Hannon (see column 8, lines 18-21. it is also noted that a #9 buckshot is usually made lead) because Hannon's or Applicant's claimed #9 buckshot elements all perform the same function of providing weight to a golf club. Therefore using #9 buckshot would have been an obvious alternative material choice to obtain the invention as specified in claim 6.

**With respect to claim 7,** Fisher discloses wherein the weight is secured within the shaft so that it is flush with the head end of the shaft (column 6, lines 62-64 indicates that slug 90 could be shorter in length and could only extend into the bore of the shaft).

**With respect to claim 8,** Fisher fails to disclose the weight to be 7.5 grams. However, he teaches that a variety of materials could be used to adjust the weight balance of the device. Since the weight of Hannon is adjustable, when one combines the Hannon's invention with Fisher's, one would select some amount of weight for the bottom weight in order to maintain an overall good balance throughout the golf club. In addition, a weight of 7.5 grams is not deemed critical because Applicant has not disclosed the purpose or the advantage of this particular weight in his specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any weight including 7.5 grams in order to adjust the weight balance of the device according to the gender and ability of a player.

**Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Green, Jr. (5,205,552). The references as applied to claim 1 above fail to disclose wherein the weight is a brass insert. However, the use of brass as a weight element in a golf club is not new because Green discloses the use of brass as a weight in a golf club head assembly (item 15 and in column 3, line 63, the weight unit is stated as a brass). It would have been obvious to one of ordinary skill in the art at the time the invention was made to

provide a brass weight in the Hannon's device as taught by Green since brass is a relatively cheap material compared to other metals.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vidovich Greg can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nini F. Legesse

09/13/04